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ATTORNEY DOCKET NUMBER: 2002834-0046 (CIP 10 - Modified Genes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bannon, et al.
Serial No.: 09/494,096
Filed: January 28, 2000
For: METHODS AND REAGENTS FOR DECREASING CLINICAL REACTION
TO ALLERGY

Examiner: Huynh, P.
Art Unit: 1644

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:


TRANSMITTAL LETTER

Enclosed are the following documents:

1. Request to withdraw finality of Office Action (3 pages); and
2. Return Postcard.

If any additional fees are required to be paid or if any overpayment has been made, please charge or credit same to Deposit Account No. 03-1721.

Respectfully submitted,

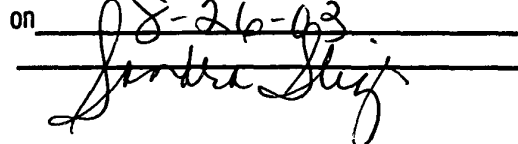

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Dated: August 21, 2003

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Sir:

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

Applicant hereby requests that the finality of the Office Action mailed July 30, 2003, in the above-referenced case be withdrawn. As described below, the finality of the Office Action is believed to be premature.

Under item 9 of the latest Office Action the Examiner states (*emphasis added*):

“The filing date of the instant claims is deemed to be the filing date of the provisional applications 60/074,590 filed 2/13/98; 60/074,624 filed 2/13/1998; 60/074,633 filed 2/13/1998 and 60/073,283 filed 1/31/1998. It is noted that priority applications USSNs 09/106,872 and 08/717,933 were not available to the examiner at this time. Therefore the examiner could not determine whether the instant claims have priority to said applications. If applicant desires priority prior to 1/31/1998, applicant is invited to point out and provide documentary support for the priority of such claims. Applicant is reminded that such priority for the instant limitations requires written description and enablement under 35 U.S.C. § 112, first paragraph.”

The art rejections made final in the Office Action rely on primary references (Burks et al., April 1997 and Stanley et al., June 1997) that fall between the credited priority date of 60/073,283 (January 31, 1998) and the claimed priority date of 08/717,933 (September 23, 1996). Further the 08/717,933 priority document includes the teachings of both Burks et al. and Stanley et al. near *verbatim* (see pp. 133-155 and 156-174, respectively). Thus, had the Examiner properly reviewed the priority documents, the rejections would have been removed and would not now be final.

Apparently, the Examiner has been unable to obtain copies of the priority documents from the Patent Office files, notwithstanding that all of the documents in question are United States patent applications properly filed with the Patent Office. Applicant respectfully submits that it cannot be Applicant's responsibility to maintain Patent Office records. Given that *10 months* have elapsed since Applicant's prior Response to Office Action, the Examiner has had plenty of time to locate the relevant files, or to request copies from Applicant if the files genuinely could not be located. Ironically, it turns out that Applicant requested *from the Patent Office* a copy of some materials from one of the priority document files, and had no trouble obtaining it. Apparently, at least that file is still in the Patent Office.

MPEP §706.07 states that "the applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end and not be prematurely cut off in the prosecution of his or her application". MPEP §706.07 further states that "the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." Applicant respectfully submits that no clear issue has yet arisen in this case between Applicant and the Examiner because the Examiner has not yet reviewed the relevant documents. In light of these facts, Applicant respectfully requests that the finality of the rejection be removed.